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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,851	09/07/1999	HENRIK PEDERSEN	5655.204-US	7651

25908 7590 02/25/2004

NOVOZYMES NORTH AMERICA, INC.  
500 FIFTH AVENUE  
SUITE 1600  
NEW YORK, NY 10110

EXAMINER

TRAN, MY CHAU T

ART UNIT PAPER NUMBER

1639

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/390,851	<b>Applicant(s)</b> PEDERSEN ET AL.	
	<b>Examiner</b> My-Chau T. Tran	<b>Art Unit</b> 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 28-55 is/are pending in the application.
- 4a) Of the above claim(s) 34,40-47 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-33,35-39,48-53 and 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of Claims*

1. Applicant's amendment filed 12/8/03 is acknowledged and entered. Claims 28, 50-53, and 55 are amended by the amendment.
2. Claims 28-55 are pending.

### *Election/Restrictions*

3. Claims 40-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 18 (dated 1/23/02).
4. Claims 34 and 54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 18 (dated 1/23/02). It is noted that applicant has stated the status of Claims 34 and 54 as being "previously presented" wherein they are "withdrawn". Thus these claims are considered to be withdrawn.
5. Claims 28-33, 35-39, 48-53, and 55 are treated on the merit in this Office Action.

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***Withdrawn Rejections***

6. Applicant's arguments, see pages 5-15, filed 12/8/03, with respect to the previous rejection under 35 USC 112, first paragraph (written description) has been fully considered and are persuasive. The previous rejection under 35 USC 112, first paragraph (written description) of claims 28-33, 35-39, 48-53, and 55 has been withdrawn.

7. Applicant's arguments, see pages 16-18, filed 12/8/03, with respect to the previous rejections under 35 USC 112, second paragraph have been fully considered and are persuasive. The rejections under 35 USC 112, second paragraph of 28-33, 35-39, 48-53, and 55 have been withdrawn.

8. Upon further reconsideration, the following new ground of rejection is made as follows.

***New Rejections***

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 28-33, 35-39, 48-53, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (US Patent 5,631,137) and Walsh (*Enzymatic Reaction Mechanisms*, 1979, pg. 22).

Martin et al. discloses several different methods for selecting catalytic moieties comprising reaction-based selection for moieties with catalytic activity and isolating the moieties (col. 4, lines 44-54) wherein catalytic moieties include catalytic peptide, polypeptide, and enzyme (col. 8, lines 56-67). The method comprise of reacting a population of catalytic moieties with the substrate wherein the subpopulation having catalytic activity will bind and engage in catalysis, and isolating that subpopulation (col. 6, lines 23-50).

The method of Martin et al. does not expressly disclose the step of regenerating the substrate by the catalyst.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the step of regenerating the substrate by the catalyst since such step is inherent in catalysis (e.g. reversing the catalysis) as disclose by Walsh (pg. 22, lines 26-29) and the addition of this step would be a choice as experimental design and is considered within the purview of the prior art. One of ordinary skill in the art would have been motivated to

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include the step of regenerating the substrate by the catalyst in the method of Martin et al. for the advantage of conversing the substrate.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 571-272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct  
February 18, 2004

  
PADMASHRI PONN  
PRIMARY EXAMINER